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10/070,056

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Bunji Mizuno

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12/08/2006

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EXAMINER

ADE, OGER GARCIA

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,056

Applicant(s)

MIZUNO ET AL.

Examiner

Garcia Ade

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on October 5th, 2006 under 37 CFR 1.131 has been considered. Applicants amended claims 2 – 9, 15 and 26.
2. The Examiner withdraws the objection of claims 2 – 8.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenchus et al. [US 7,054,824], in view of Rousseau et al. [US 2002/0001001], and further in view of Teveler et al. [US 2001/0034663].

As per claims 1 – 5, 8 – 12, 15 and 16, Rousseau discloses determining sale terms or lease terms based on the estimated remaining life of the commodity [see column 2, lines 19 – 26 (e.g. **determined using current resale**), and via step 38]; selling or renting the commodity to a second user in accordance with the sale terms or the lease terms [see column 5, lines 19 – 28 (e.g. **selling the whole product** is determined)]; collecting the commodity from the second user [see column 2, lines 45 – 63 (e.g. **collecting a resale price** for the product)]; and dismantling the commodity into a plurality of parts after the collection of the commodity from the second user, wherein the recording section records the

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information indicating the usage history of the commodity in a manner in which it is substantially impossible for a user of the commodity to alter the usage history information [see column 4, lines 7 – 12 (e.g. **dismantling** and material separation to pursue), and lines 30 – 37 (e.g. **dismantling and removal of parts** from a product)].

Grenchus does not explicitly disclose estimating a remaining life of the commodity based on information indicating a usage history of the commodity recorded in a recording section provided in the commodity. However, Rousseau discloses estimating a remaining life of the commodity based on information indicating a usage history of the commodity recorded in a recording section provided in the commodity [see abstract, and claim 13].

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify Grenchus's invention to include Rousseau's feature mentioned above. The motivation to combine would provide a method for determining estimated remaining life information for a replaceable commodity.

The combination of Grenchus and Rousseau does not explicitly disclose selling or renting a commodity to a first user and collecting the commodity from the first user. However, Teveler discloses selling or renting a commodity to a first user [see figure 3, and paragraph 0114 (e.g. **commodity buyers and sellers**)]; collecting the commodity from the first user [see paragraph 0014 (e.g. **collect buyers' requests for certain items**)].

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Grenchus and Rousseau to

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include Teveler's method of selling or renting a commodity to a first user. The motivation to combine would provide a buyer with a discount on an original purchase of a product or service, or for the extension of credit, by tying the original transaction to a contract for the long term purchase of one or more commodities [see paragraph 0023].

As per claims 6, 7, 13, and 14, Grenchus discloses the commodity includes a device for sending particular information which is particular to the commodity [column 1, lines 15 – 24 (e.g. **associated devices**)]; the particular information includes distribution information for specifying a party involved in a distribution of the commodity [see figure 1], and when the particular information from the commodity ceases, notifies a party involved in the distribution of the commodity, which is specified by the distribution information included in the most recent piece of particular information from the commodity [via value database 26, column 4, lines 39 – 47 (e.g. source of **parts values may be recent sale prices** to parts brokers)], that the particular information from the commodity has ceased [see figures 2A-2B (e.g. **information flow and decision making**)].

Response to Arguments

5. Applicants' arguments filed October 5th, 2006 have been fully considered but they are not persuasive. Applicants' arguments will be addressed herein below in the order in which they appear in the response.

A) Applicants argue with respect to feature (a) in claim 1, that Grenchus does not teach "estimating a remaining life of the commodity based on information indicating a usage history of the commodity recorded in a recording

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provided in the commodity". This feature has been rejected in view of a new ground of rejection. See rejection of claim1 above.

Applicants argue with respect to feature (b) in claim 1, that Grenchus does not teach "determining sale terms or lease terms based on the estimated remaining life of the commodity". The Examiner respectfully disagrees. Grenchus's invention provides a method of determining the optimum level of demanufacturing a product using current price data stored in a database and a spreadsheet model [see summary of the invention].

Applicants argue with respect to feature (c) in claim 1, that Teveler does not teach "selling or renting the commodity to a second user in accordance with the sale terms or the lease terms". The Examiner respectfully disagrees. The Examiner notes the abstract, figure 3, figures 3, paragraphs 114 and 126 from Teveler's published application explicitly recite this feature.

Applicant's arguments are deemed nonpersuasive, and are also moot in view of the new ground of rejection.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571.272.6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner
Art Unit 3627

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Andrew Joseph Fuchs

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